

Section c.) Remarks.

This reply is in response to the Office Action dated April 20, 2004, in which the Examiner has re-opened prosecution, and entered new grounds of rejection. Claims 9, 10 and 12 remain in the application.

The claims have been rejected as being indefinite regarding certain terms in Claim 9. Applicants have amended Claim 9 to clarify the meaning of the terms noted by the Examiner, and therefore the rejection based on Section 112 should be withdrawn.

The pending claims have also been rejected as being unpatentable on the basis of Halloran EP 1031344 in view of Kasprzak US 5,443,760, under Section 103(a). The Examiner should note, and it is pointed out, that Claim 9 calls for the presence of a silicone polyether surfactant, whereas Halloran in EP 1031344 in Paragraph [0031] specifies that the surfactant should be a non-silicon atom containing emulsifier. Since Halloran expressly teaches against the use of emulsifiers containing silicon atoms, it is not seen wherein one skilled in the art would seek or be motivated to add the silicone polyether surfactant in Kasprzak US 5,443,760 to the method in Halloran.

In particular, it is noted that the Court of Appeals for the Federal Circuit has held that "There is no suggestion to combine, if a reference teaches away from its combination with another source", *Tee Air, Inc., v. Denso Manufacturing Michigan Inc.*, 52 USPQ2d 1294 (Fed. Cir. 1999). Similarly, in *In re Haruna*, 58 USPQ2d 1517 (Fed. Cir. 2001), the Court noted that "A prima facie case of obviousness can be rebutted if the applicant . . . can show 'that the art in any material respect taught away' from the claimed invention." In addition, the Court stated that "A reference may be said to teach away when a person of ordinary skill, upon reading the

reference, . . . would be led in a direction divergent from the path that was taken by the applicant." In addition, in *Winner International Royalty Corp., v. Wang*, 53 USPQ2d 1580 (Fed. Cir. 2000), the Court indicated that "If a first prior art reference "did in fact teach away from [a second reference], then that finding alone can defeat [an] obviousness claim" based on a combination of the two references."

The claims have been further rejected as being unpatentable over Gee (US 5,891,954) under Section 103(a). As pointed out in applicant's specification in Paragraph [0006], Gee is directed to a silicone oil-in-water emulsion prepared by emulsion polymerization, but the silicone polyether in Gee is post added to the silicone oil-in-water emulsion. Gee also fails to teach the stability of such emulsions in the presence of salts and solvents.

In particular, in Gee, the silicone polyether is post added to an already prepared silicone oil-in-water emulsion, whereas Claim 9 requires that the silicone polyether be included in the first step (i) of the process, so that according to the instant invention, the silicone polyether is present in the process before the silicone oil-in-water emulsion is even formed in subsequent step (vi). Gee also fails to describe the post addition of a salt component or an alcohol component to the silicone oil-in-water emulsion as is called for in Claim 9 in step (vii). Step (vii) in Claim 9 as amended now requires that it be carried out "after" step (vi), which is also absent from Gee.

Since these several features are absent from Gee, it is not seen wherein Gee can be said to render the claims unpatentable, nor is it seen wherein the same invention is being claimed in this present application as is being claimed in Gee under the judicially created doctrine of obviousness type double patenting.

The claims have been yet further rejected as being unpatentable over Gee (US 5,891,954) under the judicially created doctrine of obviousness type double patenting. As noted above, and as pointed out in applicant's specification in Paragraph [0006], Gee is directed to a silicone oil-in-water emulsion prepared by emulsion polymerization, but the silicone polyether in Gee is post added to the silicone oil-in-water emulsion. Gee also fails to teach the stability of such emulsions in the presence of salts and solvents.

In particular, in Gee, the silicone polyether is post added to an already prepared silicone oil-in-water emulsion, whereas Claim 9 requires that the silicone polyether be included in the first step (i) of the process, so that according to the instant invention, the silicone polyether is present in the process before the silicone oil-in-water emulsion is even formed in subsequent step (vi). Gee also fails to describe the post addition of a salt component or an alcohol component to the silicone oil-in-water emulsion as is called for in Claim 9 in step (vii). Step (vii) in Claim 9 as amended now requires that it be carried out "after" step (vi), which is also absent from Gee.

Since these several features are absent from Gee, it is not seen wherein the same invention is being claimed in this present application as is being claimed in Gee under the judicially created doctrine of obviousness type double patenting.

The claims have been still further rejected as being unpatentable over Halloran (US 6,071,975) under the judicially created doctrine of obviousness type double patenting. As noted above, Claim 9 calls for the presence of a silicone polyether surfactant, whereas Halloran in US 6071975EP in Column 5 lines 31-33 specifies that the surfactant should be a non-silicon atom containing emulsifier. Since Halloran expressly teaches against the use of emulsifiers containing

silicon atoms, it is not seen wherein one skilled in the art would seek or be motivated to add a silicone polyether surfactant in the method in Halloran.


In particular, it is noted that the Court of Appeals for the Federal Circuit has held that "There is no suggestion to combine, if a reference teaches away from its combination with another source", *Tee Air, Inc., v. Denso Manufacturing Michigan Inc.*, 52 USPQ2d 1294 (Fed. Cir. 1999). Similarly, in *In re Haruna*, 58 USPQ2d 1517 (Fed. Cir. 2001), the Court noted that "A prima facie case of obviousness can be rebutted if the applicant . . . can show 'that the art in any material respect taught away' from the claimed invention.". In addition, the Court stated that "A reference may be said to teach away when a person of ordinary skill, upon reading the reference, . . . would be led in a direction divergent from the path that was taken by the applicant." In addition, in *Winner International Royalty Corp., v. Wang*, 53 USPQ2d 1580 (Fed. Cir. 2000), the Court indicated that "If a first prior art reference "did in fact teach away from [a second reference], then that finding alone can defeat [an] obviousness claim" based on a combination of the two references."

Since this feature is absent from Halloran, it is not seen wherein the same invention is being claimed in this present application as is being claimed in Halloran under the judicially created doctrine of obviousness type double patenting.

The Examiner is therefore requested to withdraw the rejections and pass the case to issue.

Respectfully submitted,

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